

REMARKS

Claims 42-45, 48-61, and 80-88 are currently pending.

Improper Rejection under 35 U.S.C. 102(b)

35 U.S.C. 102(b) states as follows: "Conditions for patentability; novelty and loss of right to patent. A person shall be entitled to a patent unless ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, **more than one year prior to the date of application** for patent in the United States."

It is not clear if the subject matter from Applicant's background of the invention were described in a publication or patented more than one year prior to the Applicant's date of application for patent in the United States.

As such, the rejection of the claims based on 35 U.S.C. 102(b) does not seem to be appropriate.

Claim Rejections under 35 U.S.C. 102(b)

The Patent Office rejected claims 42, 45, 48, 56-58, 60, and 61 under 35 U.S.C. 102(b) as being anticipated by Applicant's Background of the Invention (APA) on pages 1-4.

For a claim to be anticipated, each and every non-inherent claim limitation must, in generally, be disclosed in a single reference. (From MPEP 2131)

There are five independent claims: 42, 61, 80, 83, and 84. Independent claims 42 and 61 have been rejected as anticipated by APA. The other independent claims 80, 83, and 84 have each been rejected by APA as the primary reference. These claims have been reproduced immediately below.

Claim 42 recites as follows:

A method comprising: routing a message, message set, or session setup request from a first network to a second network, the message, message set, or session set up request comprising a first type of address, the routing comprising **checking requirements of a message, set of messages, or session included in the message, message set, or session set up request**, and deciding, based on the

result of the requirements checking, on the routing of the message, message set, or session setup request, **wherein the requirements include at least one of media requirements or QoS requirements of the message, set of messages, or requested session.**

Claim 61 recites as follows:

A system comprising: a router configured to route a message, message set, or session setup request from a first network to a second network, the message, message set, or session set up request comprising a first type of address, wherein the system is configured to **check requirements of a message, set of messages, or session from the message, message set, or session set up request**, and decide, based on the result of the requirements check, on the routing of the message, message set, or session setup request, **wherein the requirements include at least one of media requirements or QoS requirements of the message, set of messages, or requested session.**

Claim 80 recites as follows:

An apparatus comprising: a processor configured to **check requirements of a message, message set, or session setup request** to be routed from a first network to a second network; decide, based on the result of the check, on the routing of the message, message set, or session setup request; derive the routing address of the message, message set, or session set up request in the second network using a database; and route the message, message set, or session set up request to a further network entity based on the derived address.

Claim 83 recites as follows:

An apparatus comprising: means for **checking requirements of a message, message set, or session set up request** to be routed from a first network to a second network; means for deciding, based on the result of the check, on the routing of the message, message set, or session set up request; means for deriving the routing address of the message, message set, or session set up request in the second network using a database; and means for routing the message, message set, or session set up request to a further network entity based on the derived address.

Claim 84 recites as follows:

A method comprising: receiving a message, message set, or session setup request to be routed from a first network to a second network; **checking requirements of the message, message set, or session setup request** to be routed from the first network to the second network; deciding, based on the result of the check, on the routing of the message, message set, or session setup request; deriving a routing address of the message, message set, or session setup request in the second network using a database; and routing the message, message set, or session setup request to a further network entity based on the derived address.

The rejection of all independent claims is based on the following analysis by the Patent Office of the claimed subject matter of independent claim 42. This analysis is reproduced from the Final Office Action dated August 25, 2009, immediately below, as follows:

Regarding claim 42, the APA discloses a method for routing a E.164 message from a user in an originating network to a subscriber in the terminating network via a foreign network, wherein the originating network and the foreign network are considered the first and the second network, respectively. The E.164 represents the international phone numbering system, or the E.164 identity, which is considered as a first type of address.

checking requirements of message or set of messages or session from the message or message set or session set up request (checking if the E.164 number is a valid IMS identity, see page 1, lines 34-35), and

deciding based on the result of the requirements checking step, on the routing of the message or message set or session setup request (if the E.164 is a valid IMS, the message would be routing to an own MGCF, see page 2, lines 27-35),

wherein the requirements include at least one of media requirements or QOS requirements of the message, set of messages, or requested session (the step of checking if the E.164 being a valid IMS includes obtaining the valid IMS identity in the trusted networks or in the target network, see page 2, lines 21-28).

A brief description of certain terms are in order. DNS stands from Domain Name System. NAPTR stands for Naming Authority Pointer. RR stands for Resource Record of DNS.

Paragraph 0006 of Applicant's corresponding U.S. Published Patent Application No. 2005/0286531, provides as follows:

[0006] The task of the ENUM-DNS database is to give answer whether the target identifier, i.e. the E.164 number, is a valid IMS identity and if yes, give one or more NAPTR. There is not always a correct answer when E.164 belongs to the number range if non-IMS (e.g. GSM) and IMS number ranges overlap. In more detail, the ENUM-DNS database is used to answer the question Q1 "Is the target E.164 a valid IMS identity?" of S-CSCF (S-CSCF=Serving Call State Control Function) in the originating message and/or set of messages and/or session and to return one or more NAPTR (NAPTR=Naming Authority Pointer; RR of DNS; RR=Resource Record of DNS) if the answer is positive. With these NAPTR RRs the E.164 can be converted to a valid IMS routing address that is used to route the message and/or set of messages and/or session to the target network.

The Patent Office has asserted that ENUM-DNS, which provides information whether E.164 number is a valid IMS identity, performs QoS or media requirement checking.

However this is not the case. Using ENUM, a telephone number can be stored in DNS such that a DNS lookup on the number returns a URI associated with an IP identity of a user, such as a SIP URI, an H.323 URL, or a mailto: URL. URI does not have any information regarding media or QoS requirements of the message itself.

An examination of Applicant's Figure 14, reproduced below, should be helpful. Paragraph 0034 of corresponding U.S. Published Patent Application No. 2005/0286531, discloses "FIG. 14 shows a further embodiment providing enhanced routing based on media and/or QoS and/or other requirements..." Figure 14 shows three boxes, one labeled usual S-CSCF functionality, a second as new functionality in S-CSCF or BGCF, and the third as usual BGCF functionality. From the flow chart of Figure 14, it is evident that if a response to an ENUM-DNS query does not contain at least one NAPTR RR (step S2), then the media and/or QoS and/or other requirements of the message/ messages/ session are checked (step S6).

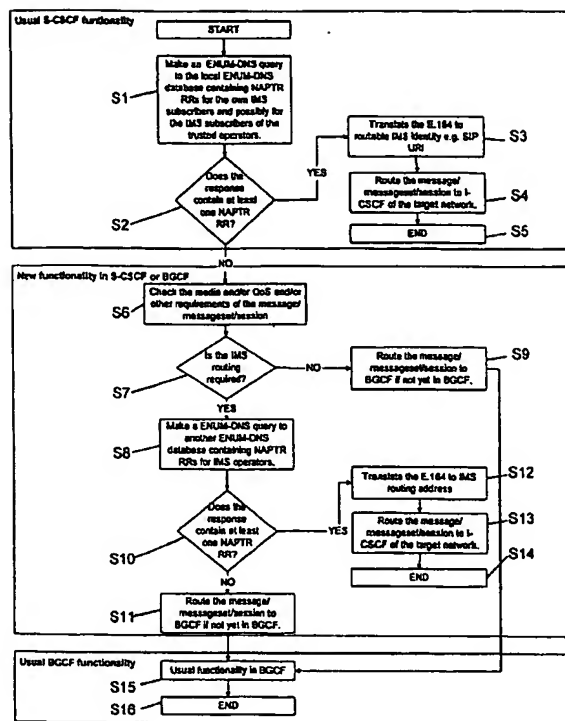


FIG. 14

It is clear from Figure 14 that **“checking requirements of a message, set of messages, or session included in the message, message set, or session set up request”** is not related to **“checking if the E.164 number is a valid IMS identity,”** as asserted by the Patent Office. The logic of Figure 14 is that if in step S2, the response to the ENUM-DNS query contains at least one NAPTR RR, then processing diverges to step S3 where the E.164 is translated to a routable IMS identity (e.g., SIP URI). If there is no NAPTR RR in the response, then processing proceeds to step S6 for checking the media and/or QoS and/or other requirements of the message/ messages/ session is performed.

Thus, APA does not disclose **“checking requirements of a message, set of messages, or session included in the message, message set, or session set up request,”** recited by claim 42, and similarly or identically recited by remaining independent claims 61, 80, 83, and 84.

So, claims 42-45, 48-61, and 80-88 are not anticipated by APA.

Claim Rejections under 35 U.S.C. 103(a)

The Patent Office rejected claims 43, 44, 49-55, 59, 80-85, 87, and 88 under 35 U.S.C. 103(a) as being unpatentable over APA in view of Figure 17.3.2.1-1, page 531, of 3GPP TS24.228 V5.0.0, March 2002, pp. 1-681 (TS24.228).

The Patent Office asserted on pages 4-5 of the Final Office Action dated August 25, 2009, as follows:

Regarding claim 43, the APA discloses all claimed limitation, except a step of deriving the address of a contact point of the second network in the first network, wherein the message is forwarded to the second network using the contact point of the second network.

The 3GPP discloses signaling flows for the IP multimedia call control based on SIP and SDP, see figure 17.3.2.1-1, pages 531-566. The S-CSCF#1 is the contact point of the Home Network #1 or the second network.

As discussed above, APA does not disclose **“checking requirements of a message, set of messages, or session included in the message, message set, or session set up request,”** recited by claim 42, and similarly or identically recited by remaining independent claims 61, 80, 83, and 84. APA also does not suggest this claimed subject matter.

TS24.228 (3GPP) is not seen to remedy this deficiency of APA. Figure 17.3.2.1-1 of TS24.228 (3GPP) is reproduced below.

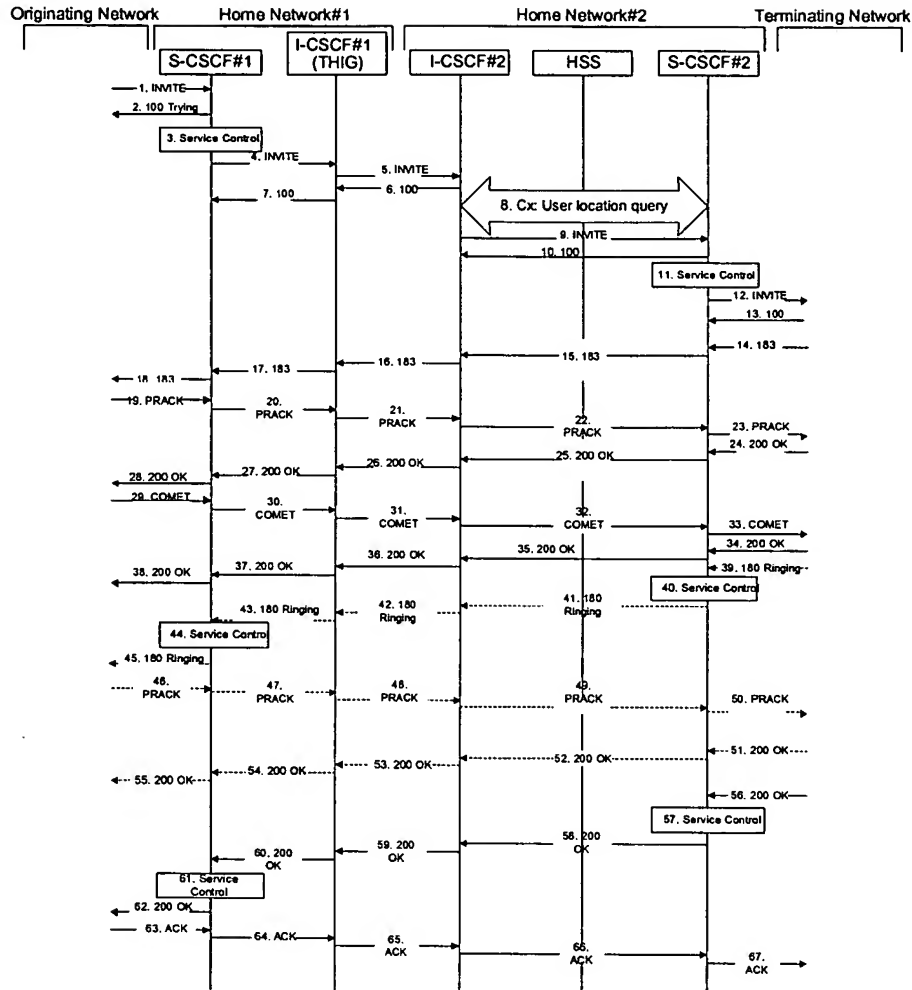


Figure 17.3.2.1-1: S-S#1b

Since neither APA nor TS24.228 (3GPP) disclose or suggest “**checking requirements of a message, set of messages, or session included in the message, message set, or session set up request,**” recited by claim 42, and similarly or identically recited by remaining independent claims 61, 80, 83, and 84, no purported combination of these two references would disclose or suggest this claimed subject matter.

Thus, claims 43, 44, 49-55, 59, 80-85, 87, and 88 are not made obvious by APA in view of TS24.228 (3GPP).

The Patent Office is respectfully requested to reconsider and remove the rejections of the

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claims 42-45, 48-61, and 80-88 under 35 U.S.C.102(b) based on APA and under 35 U.S.C. 103(a) based on APA in view of TS24.228 (3GPP), and to allow all of the pending claims as now presented for examination. An early notification of the allowability of now pending claims 42-45, 48-61, and 80-88 is earnestly solicited.



Serial No.: 10/521,155

Art Unit: 2419

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November 12, 2009

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